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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,622	03/19/2002	Alain Durand	PT990063	5517

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EXAMINER

SHIFERAW, ELEN I A

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/088,622	Applicant(s) DURAND ET AL.	
	Examiner Eleni A. Shiferaw	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 6-11, filed on 06/30/2006 have been fully considered but they are not persuasive. The examiner would like to point out that this action is made final (MPEP 706.07a).

Response to Amendment

The Applicant's first argument concerns reference D'Amico et al.'s col. 3 lines 4-10 PIN code not being PIN code of the network, as recited in claims 1 and 9, remark page 2 par. to. Page 3 lines 3. The examiner respectfully disagrees with the Applicant's contentions. First, the Examiner cited col. 3 lines 4-10 for Applicant's limitation wherein said "said device sending said PIN code and a device identifier to said central controller of the existing network", D'Amico clearly discloses the portable device sending portable identification number and **key code/PIN code** to access point for network registration as claimed. Second, the access point network is registering the mobile device by requesting PIN code so the mobile device's PIN code will become a PIN code of the access point network by checking in the access point database to validate received PIN code and if found, the access point transmits portable identification number to the new device see, **abstract**, col. 5 lines 39-44, col. 5 lines 33-38, and lines 46-47. Third, PIN code of the network is not clearly claimed as argued. Fourth, D'Amico et al. is cited for this limitation when the Office sends actions three times and the Applicant is never argued regarding this issue before.

As per Applicant's argument concerning references failure to teach a method for registering a device in a wireless network comprising the steps of asking the user, through a user interface, whether he wants to install a new network or to install the device on an existing network and incase the user wants to install the device on an existing network asking the user to enter a PIN code, as recited in claims 1, and 9, remark page 3 lines 3-10 and lines 11-15, col. 4 lines 11-page 5 lines 10, and col. 5 lines 25-col. 6 lines 4. The examiner disagrees with the Applicant's contention. D'Amico et al. discloses a method for **registration of a portable unit on an existing network** utilized in a communication system that comprises a network controller, having a database for storing portable identification numbers, a base station, and a portable unit, wherein the subscriber communicates to the network controller. The registration step comprises exchanging link identification number for over-the-air registration and the portable identification number. The network controller determines whether the portable identification number is in the network controller database and transmit registration signal to the mobile device see, abstract, and claim 1. Turunen discloses a method of **registering a mobile device in a new GSM cellular telephone network** see, fig. 3 and the method comprising sending a security key from the remote station to mobile device to secure subsequent data transmission see claim 1.

Regarding argument concerning D'Amico et al. failure to ask the user to enter a PIN code, as recited in claims 1 and 9 remark page 3 lines 16. The examiner respectfully disagrees with the Applicant's contention. PIN code of the mobile device is provided by the mobile device to the access point network for registration see, col. 3 lines 33-34, claim 1 and col. 5 lines 23-27.

Regarding argument concerning D'Amico et al.'s subscriber identification number not being an authentication key. The examiner disagrees with the Applicant's contention. First, the

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Examiner never cited D'Amico et al. for teaching the identification number/authentication key for authenticating communication see Office Action mailed on 04/03/2006 page 3 lines 14-21 wherein Bjorklund is cited for disclosing base station access point generating an authentication key/network key and storing the generated authentication key on target wireless device/remote station for use in authentication procedures between the mobile device and base station access point see col. 5 lines 6-10, 47-56, fig. 3b, elements 16, 18-21 and 23, and col. 2 lines 32-35.

Regarding argument concerning D'Amico et al. failure to teaches limitation wherein "checking by said existing central controller whether the entered Pin code corresponds to a PIN code of the existing network, and if such checking is positive, sending an authentication key of the existing network from the existing central controller device" as recited in claims 1 and 9, remark 3 lines 25-28. The examiner disagrees with the Applicant's contention. D'Amico et al. discloses a database that stores portable identification numbers (PIN codes) of mobile devices and when during registration the access point determines whether the received PIN code is in the database and approving the mobile subscriber by transmitting identification number (see claim 1). Nevertheless, the identification number transmitted is not for authentication communications between the mobile device and existing access point network. Bjorklund discloses base station access point generating an authentication key/network key and storing the generated authentication key on target wireless device/remote station for use in authentication procedures between the mobile device and base station access point see col. 5 lines 6-10, 47-56, fig. 3b, elements 16, 18-21 and 23, and col. 2 lines 32-35. Sufficient motivation to combine is provided.

Regarding Applicant's argument concerning D'Amico et al. failure to disclose "storing said authentication key of the existing network by said device for use in authentication

procedures between said device and said existing central controller”, as recited in claims 1 and 9, remark page 3 last par. The examiner respectfully disagrees with Applicant and would like to draw the Appellant’s attention to col. 5 lines 19-56 and fig. 3b element 23 wherein Bjorklund discloses the mobile remote station adapter storing Knet (name) in protected memory and also D’Amico discloses storing identification number in the mobile device (see, claim 2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over D’Amico et al. (D’Amico, Patent Number: 5,077,790) in view of Bjorklund et al. (Bjorklund, EP 0658021 A1 IBM) and Turunen USPN 6,477,644 B1.

Regarding claims 1 and 9, D’Amico discloses method for registering a device in a wireless network comprising:

in case the device is to be installed on existing network comprising an existing central controller (col. 3 lines 33-34, claim 1/col. 5 lines 23-27 and col. 2 lines 52-56):

(e) asking the user to enter a PIN code (col. 3 lines 33-34, claim 1/col. 5 lines 23-27 and col. 2 lines 52-56);

(f) said device sending said PIN code and a device identifier to said central controller of the existing network (col. 1 lines 41-54, col. 3 lines 4-10; *sending portable identification number and key code to access point for network registration*);

(g) checking by said existing central controller of the existing network whether the entered PIN code corresponds to a PIN code of the existing network and if such checking is positive, generating an authentication key and sending an authentication key of the existing network from said existing central controller to said device (col. 5 lines 39-44, col. 5 lines 33-38, and lines 46-47; *the database is checked and authentication key or encrypted subscriber identification number is sent to the new device*); and

(h) storing said authentication key in said device (claim 2, and col. 3 lines 50-55),

D'Amico fails to explicitly teach the stored authentication key (encrypted subscriber identification number) being for use in authentication procedures between said device and said central controller of the existing network;

However **Bjorklund** teaches an access point/base station generating an authentication key/network key (col. 5 lines 6-10), and the storing the generated authentication key on target wireless device/remote station (col. 5 lines 47-56 and fig. 3b elements 16, 18, 19, 20, 21, and 23) for use in authentication procedures between said device and said central controller (col. 2 lines 32-35, and col. 6 lines 29-32).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Bjorklund within the system of D'Amico because it is very well known to provide authentication key for wireless for use in authentication procedures during mobile device installation (col. 2 lines 32-35, and col. 4 lines 24-33). One

would have been motivated to incorporate the teachings of storing authentication key for use in authentication procedures because it would authenticate wireless communications between mobile device, access point/base station/central controller as it is well known (col. 2 lines 32-35, and col. 6 lines 29-32).

D'Amico and Bjorklund fail to explicitly disclose the steps of registering a mobile device with a new network;

However **Turunen** discloses registering a mobile device in a new network (fig. 3) comprising:

(a) asking a user, through a user interface, whether he wants to install a network or install a new said device on a network, and in case the user wants to install a new network (col. 5 lines 42-54; *a mobile host 9 of corporate LAN 3 ...new cellular telephone network/GSM/LAN*):

(b) asking the user to enter a PIN code, said entered PIN code becoming the PIN code of the new network (col. 5 lines 49-60);

(c) generating an authentication key which becomes the authentication key of the new network (col. 5 lines 60-67); and

(d) the device becoming the central controller of the network (col. 6 lines 1-40), and

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of wireless device registration in a new network within the combination system of D'Amico Bjorklund because it would register a device in a different network. One would have been motivated to do so because it would allow a mobile device registration in another network or GSM.

Regarding claim 6, D'Amico, Bjorklund, and Turunen disclose all the subject matter as described above. In addition both teach a method, wherein the authentication key generated at step (c) is generated by a random generator (D'Amico col. 4 lines 26-41, and Bjorklund col. 6 lines 35-49). The rationale for combining are the same as claim 1 above.

Regarding claims 7 and 10, D'Amico, Bjorklund, and Turunen disclose all the subject matter as described above. In addition both teach a method, wherein the authentication key generated at step (c) is the result of a function depending on a device identifier and on said PIN code of the network (D'Amico col. 3 lines 45-55, and Bjorklund col. 5 lines 2-56).

Regarding claims 8 and 11, D'Amico, Bjorklund, and Turunen disclose all the subject matter as described above. In addition both teach a method, wherein said authentication key of the network is encrypted using a secret session key before being sent to said device, the secret session key being previously negotiated between said device and said central controller (D'Amico col. 3 lines 50-53, and Bjorklund col. 5 lines 37-43).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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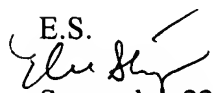
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.S.


September 22, 2006

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9/22/06